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GREENBLUM & BERNSTEIN PLC
1950 ROLAND CLARKE PLACE
RESTON VA 20191

In re Patent No. 6,764,569	:	
Issue Date: July 20, 2004	:	
Application No. 09/744,149	:	DECISION ON PETITION
Filed: July 3, 1999	:	
Attorney Docket No. 225/49578	:	

This is a decision on the petition under 37 C.F.R. §1.378(b) to accept the unavoidably delayed payment of the maintenance fee, filed June 9, 2011.

The petition under 37 C.F.R. § 1.378(b) is **DISMISSED**.

Background

The above-identified patent issued on June 20, 2004. Accordingly, the first maintenance fee could have been timely paid during the period from June 20, 2007 through December 20, 2007, or with a late payment surcharge during the period from December 21, 2007 through June 20, 2008. No maintenance fee having been received, the patent expired on June 21, 2008.

According to petitioner, there were three co-assignees of the instant application - DaimlerChrysler AG (hereinafter "Daimler"), Fraunhofer-Gesellschaft zur Forderung der angewanten Fourschung e.V. (hereinafter "Fraunhofer"), and Henkel KgaA (hereinafter "Henkel"). The three co-assignees had an agreement that while the application was pending, Daimler would be responsible for communicating with US counsel. Furthermore, after issuance, Daimler would remain responsible for tracking and paying the maintenance fees.

Petitioner states that per the USPTO's PAIR system, on October 1, 2004, Dennemeyer & Co. Luxembourg was assigned the address for fee purposes (the "fee address" is the address to which the USPTO would mail any courtesy maintenance fee reminder). In May and June of 2005, Fraunhofer purchased Daimler's and Henkel's share in the invention, becoming the sole owner of the instant patent.

After the purchase was completed, Ms. Stephanie Lindner, an employee of Fraunhofer, undertook the task of instructing annuity service company Pavis to maintain the European patents for those that were purchased. However, Lindner did not enter the due dates in Fraunhofer's internal docketing system and did not inform Pavis of the instant US patent or of the dates for maintaining the instant patent.

The expiration of the instant patent was discovered in February of 2011, due to Fraunhofer's conducting a routine check of their database.

Relevant Statutes and Regulations

35 U.S.C. § 41(c)(1) states that:

The Commissioner may accept the delayed payment of any maintenance fee required ... after the six month grace period if the delay is shown to the satisfaction of the Commissioner to have been unavoidable.

37 C.F.R. § 1.378(b) provides that:

Any petition to accept an unavoidably delayed payment of a maintenance fee must include:

(1) The required maintenance fee set forth in §1.20(e) through (g);

(2) The surcharge set forth in §1.20(i)(1); and

(3) A showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent. The showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.

§ 1.378(b)(3) is at issue in this case. Acceptance of a late maintenance fee under the unavoidable delay standard is considered under the same standard for reviving an abandoned application under 35 U.S.C. § 133. This is a very stringent standard. Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word 'unavoidable' ... is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. In addition, decisions are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith, 671 F.2d at 538, 213 U.S.P.Q. at 982. Nonetheless, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines, 673 F. Supp. at 316-17, 5 U.S.P.Q.2d at 1131-32 (N.D. Ind. 1987).

Moreover, delay resulting from the lack of knowledge or improper application of the patent statutes, rules of practice or the Manual of Patent Examining Procedure, however, does not constitute "unavoidable" delay.

35 U.S.C. § 41(c)(1) does not require an affirmative finding that the delay was avoidable, but only an explanation as to why the petitioner has failed to carry his or her burden to establish that the delay was unavoidable. Cf. Commissariat A. L'Energie Atomique v. Watson, 274 F.2d 594, 597, 124 USPQ 126, 128 (D.C. Cir. 1960) (35 U.S.C. § 133 does not require the Commissioner to affirmatively find that the delay was avoidable, but only to explain why the applicant's petition was unavailing). Petitioner is reminded that it is the patentee's burden under the statutes and regulations to make a showing to the satisfaction of the Commissioner that the delay in payment of a maintenance fee is unavoidable. See Rydeen v. Quigg, 748 F. Supp. 900, 16 USPQ2d

1876 (D.D.C. 1990), aff'd 937 F.2d 623 (Fed. Cir. 1991), cert. denied, 502 U.S. 1075 (1992); Ray v. Lehman, 55 F. 3d 606, 608 - 609, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995).

Analysis

Petitioner has not demonstrated unavoidable delay within the meaning of 35 U.S.C. §41(c)(1) and 37 C.F.R. § 1.378(b).

Upon review of the petition, it is unclear what party was responsible for tracking and paying the maintenance fee in this patent. In accordance with the law, a patent will expire if the maintenance fee is not paid on time and thus no action is required on the part of the USPTO since it is patentee's burden to keep the patent in force. The maintenance fee may be accepted by the Director of the USPTO if it is shown that the delay in submission of the maintenance fee was unavoidable. In this regard, it is unclear from the record whether Daimler, Dennemeyer & Co., or Fraunhofer was responsible for tracking and paying the maintenance fee. It is required that petitioner state the name of the party responsible for tracking and paying the maintenance fee for this patent.

If Fraunhofer was the party responsible, it is true that the error of Lindner to enter the instant patent into their tracking system may be unavoidable delay. As set forth in MPEP 711.03(c):

A delay resulting from an error (e.g., a docketing error) on the part of an employee in the performance of a clerical function may provide the basis for a showing of "unavoidable" delay, provided it is shown that:

- (A) the error was the cause of the delay at issue;
- (B) there was in place a business routine for performing the clerical function that could reasonably be relied upon to avoid errors in its performance; and
- (C) the employee was sufficiently trained and experienced with regard to the function and routine for its performance that reliance upon such employee represented the exercise of due care.

Conclusion

Any request for reconsideration of this decision must be filed within **TWO MONTHS** of the mailing date of this decision. Any such petition for reconsideration must be accompanied by the \$400 petition fee set forth in §1.17(f). After decision on the petition for reconsideration, no further reconsideration or

review of the matter will be undertaken by the Commissioner.
Accordingly, on request for reconsideration, it is extremely important that petitioner supply any and all relevant information and documentation in order to meet his burden of showing unavoidable delay. This includes statements by all persons with direct knowledge of the cause of the delay, setting forth the facts as they know them.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petitions
 Commissioner for Patents
 P.O. Box 1450
 Alexandria VA 22313-1450

By FAX: (571)273-8300
 Attn: Office of Petitions

Telephone inquiries concerning this communication should be directed to the undersigned at 571-272-3207.

A handwritten signature in cursive script, appearing to read 'Cliff Congo'.

Cliff Congo
Petitions Attorney
Office of Petitions